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T.B.

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/829,678 04/09/01 CIMINO

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023552
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MINNEAPOLIS MN 55402-0903

QM32/0619

EXAMINER

THISSELL, J

ART UNIT

PAPER NUMBER

3763

3

DATE MAILED:

06/19/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/829,678

Applicant(s)

CIMINO, WILLIAM W.

Examiner

Jeremy Thissell

Art Unit

3763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

I. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claims 1, 4, and 7 are somewhat unclear because of the passage that reads "A protective sheath for an ultrasonic fragmenting device includes a..." The passage continues on to describe all the features included in the ultrasonic fragmenting device, but the way that passage reads, it sounds like it's the sheath that "includes..." Perhaps it would be clearer if it read, "A protective sheath for an ultrasonic fragmenting device, the ultrasonic fragmenting device including..."

The preamble of claims 1, 4, and 7 (which is the same for each) claims "a sheath for use with an ultrasonic fragmenting device", so the ultrasonic fragmenting device is not positively recited. Because of this, claim 4 is indefinite because it positively recites a flange on the ultrasonic fragmenting device, whereas the ultrasonic fragmenting device was previously in functional language only. These claims also recite "a hollow sleeve having a proximal end and a distal end and surrounding the elongate ultrasonic probe". This positively recites the ultrasonic probe and lacks proper antecedent basis.

Claim 10 positively recites that "...the termination is located at or near the most distal vibratory node of the elongate ultrasonic probe". The ultrasonic probe is not previously positively recited and thus this passage lacks antecedent basis.

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As previously mentioned the claims have been interpreted to claim a sheath. Any details concerning the ultrasonic device must be in functional language. If applicant wishes these details concerning the ultrasonic device and its physical relationship to the sheath, applicant must include positive recitations of the ultrasonic device so that proper antecedent basis exists.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

II. Claims 1, 3, 7, 9-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Geuder (5,879,356).

Geuder teaches the ultrasonic device substantially as claimed, including a sleeve 28, made of polymeric material (col. 4, line 28 "polyamide"), and having a termination at a distal end that forms a barrier when the sleeve is placed over the ultrasonic probe. Geuder also teaches the method as claimed which is merely the basic use of the device for phacoemulsification which is well known in the art.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

III. Claims 2 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Geuder (5,879,356).

Geuder teaches that the sleeve is made out of a polymeric material such as polyamide and therefore does not inherently read on claims 2 and 8. However, the desired structural properties of the sleeve (i.e. rigid, non-collapsible) are often met by using metal materials. The examiner takes the position that it would have been an obvious matter of design choice for one of ordinary skill in the art to choose a metal material to form the sleeve out of, especially since rigid medical conduits are often formed out of metal such as surgical stainless steel. The metal would provide better durability than the plastic.

IV. Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Geuder in view of Quaid et al (5,123,903).

Geuder teaches all the claimed subject matter except for having a termination or projection at the distal end of the probe (rather than on the sleeve). Quaid teaches that the projection found on the inside of the sleeve could also be on the probe itself. It would have been obvious to one of ordinary skill in the art at the time the invention was made to form the device of Geuder with the projection on the probe instead of on the sleeve, since it has been held that rearranging of parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

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Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-11 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 6,224,565. Although the conflicting claims are not identical, they are not patentably distinct from each other.

Contacts

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeremy Thissell whose telephone number is (703) 305-5261. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Seidel can be reached on (703) 308-5115.

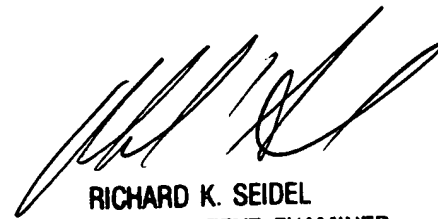
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June 15, 2001



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